

REMARKS/ARGUMENTS

Responsive to the Final Office Action dated April 18, 2008, Applicants have filed A Request for Continued Examination and this Preliminary Amendment. Claims 1 - 20 are pending for prosecution. Claims 1, 8, and 15 are independent and have been amended. Applicant respectfully requests reconsideration the rejected claims.

I. Claim Rejection Under 35 U.S.C. § 103

A. Obviousness

When determining the question of obviousness, underlying factual questions are presented which include (1) the scope and content of the prior art; (2) the level of ordinary skill in the art at the time of the invention; (3) objective evidence of nonobviousness; and (4) the differences between the prior art and the claimed subject matter. Graham v. John Deere Co., 383 U.S. 1, 17-18, 148 USPQ 459, 467 (1966). Moreover, with regard to the last prong of the *Graham* inquiry, “[i]o determine whether there was an apparent reason to combine the known elements in the way a patent claims, it will often be necessary to look to interrelated teachings of multiple patents; to the effects of demands known to the design community or present in the marketplace; and to the background knowledge possessed by a person having ordinary skill in the art. To facilitate review, this analysis should be made explicit.” KSR International v. Teleflex Inc., 127 U.S. 1727 (2007).

The person of ordinary skill in the art is a hypothetical person who is presumed to know the relevant prior art. Custom Accessories, Inc. v. Jeffrey-Allan Indus., Inc., 807 F.2d 955, 962, 1 USPQ2d 1196, 1201 (Fed. Cir. 1986). The level of ordinary skill in the art of computer programming may be determined by looking to the references of record. In re GPAC, Inc., 57 F.3d 1573, 35 USPQ2d 1116 (Fed. Cir. 1995). The references of record in this case reveal that a

moderately high level of sophistication is present in the subject area of the subject area of the instant application. Thus, Applicant submits that, as substantiated by the cited references, those with at least a bachelor's degree in computer science or some experience in computer programming or the like would most likely be a person with ordinary skill in this field of endeavor.

With respect to objective evidence of nonobviousness, Applicant submits that the record supports the conclusion that there are long-felt but unsolved needs met by the present invention. For at least this reason Applicant respectfully submits that the claimed invention is not obvious in view of the cited references.

Finally, *prima facie* obviousness requires that there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the references. This motivation-suggestion-teaching test informs the Graham analysis. “To reach a non-hindsight driven conclusion as to whether a person having ordinary skill in the art at the time of the invention would have viewed the subject matter as a whole to have been obvious in view of multiple references,” there must be “some rationale, articulation, or reasoned basis to explain why the conclusion of obviousness is correct.” In re Kahn, (Fed. Cir. 2006). The recent *KSR International* decision by the Supreme Court has not eliminated the motivation-suggestion-teaching test to determine whether prior art references have been properly combined. Rather, in addition to the motivation-suggestion-teaching test, the Court discussed that combinations of known technology that are “expected” may not be patentable. Stated in the affirmative, therefore, combinations are nonobvious and patentable if unexpected. In the present application, no single prior art reference nor any

combination thereof (legitimate or otherwise) meets the claimed limitations of Applicant's invention.

B. Rejection of Claims 1-20

Claims 1-20 were rejected under 35 U.S.C. § 103(a) as being unpatentable over Walker et al. (U.S. Pat. No. 6,978,248). For the following reasons, Applicant respectfully requests reconsideration and withdrawal of this rejection.

Applicant respectfully disagrees with the assertions made by the Examiner that Walker teaches all of the claimed portions of the instant application. Clearly, Walker teaches two basic functions (1) reduced costs by pre-testing via e-mail a resultant physical postal mailing, and (2) identifying which purchased physical postal mail list will provide the highest rates of return based upon pre-testing via e-mail. Walker makes these claims throughout the patent, starting with the Abstract, repeated in col. 1, line 46 through col. 2, line 28, again in col. 2, lines 39-44, and in numerous additional locations in the detailed description. Additionally, these claims are illustrated in Figure 7, item 707 and Figure 10, item 1007. Walker fails to disclose modifications to the technique for the resulting outbound communication to be an e-mail rather than a physical postal mail as claimed in amended Claims 1, 8 and 15. In fact, Walker discloses the contrary:

The impact of a direct marketing e-mail mailing is not nearly as high as that of a postal mailing, however. The postal mailing is a more tangible good in the prospective consumer's hand. Also a person is more likely to flip through a longer brochure at home than to click through one at their PC terminal. Thus, e-mail can be an excellent vehicle for relatively small brochures, but **the postal mailing remains the most effective process for attracting the buying power of a consumer.** Thus, a need exists for a business to be able to efficiently and cost-

effectively select an appropriate postal mailing list before investing a large amount of resources into utilizing the mailing list. Col. 2, lines 16-28 (emphasis added).

Thus, key aspects of all the independent claims are clearly distinct not just from Walker's carefully worded claims, but also from the stated intent in the body of the patent as well.

In addition to the broad scope of the differences between the current application and Walker, Walker also deviates in several specific details from the current application. The Examiner asserts on page 2 of the Office Action dated 4/18/2008 that Walker, in col. 7, lines 6-39 and col. 10, lines 17-34, claims that "...each having a message content identical in each test message and a plurality of characteristics that may vary...". The Examiner is reading content into Walker that is not evident from the cited areas. In the section referenced by the Examiner, Walker only discloses changing the message content and never even discusses other sections of an e-mail that are well known in the art. In fact, Figures 5A, 5B, 6A and 6B all demonstrate a variety of data structures that reference only a single characteristic (the question in Walker's terminology). Clearly Walker's focus is the exact opposite from the explicit wording in the claim of the current application where the message content is identical and the other characteristics on an e-mail vary.

The Examiner continues on page 3 citing col. 7, lines 52-58 and col. 8, lines 6-28 as examples of how Walker creates and sends an e-mail as the result of the test e-mail process. Walker does no such thing; rather, Walker focuses on the resulting physical postal message whereas the current application focuses on the resulting electronic e-mail message.

The Examiner further asserts that Walker teaches paying and employing the testing group and posits that one of ordinary skill in the art would generalize Walker's payment of the test

group to include payment of the recipient of the postal mail. Applicant disagrees that this is evident from Walker, and, in fact, is not even relevant to the current application since no such claims are made.

Additionally, the Examiner notes that in relation claims 2 through 5 of the present application, conventional e-mails contain the variety of fields explicitly mentioned in these claims. Walker fails to mention the variety of characteristics as are considered by the current claims, specifically failing to mention these characteristics as related to a final e-mail message as considered by the current amended claims. As noted earlier, Walker only references a single characteristic, the body of the e-mail, which in the invention encodes a question with which to test against a sample population. Walker fails to disclose the variety of characteristics that are clearly claimed by the amended claims such as the subject of the message, time of delivery of the message, the address from which the message originates, and an address to which a reply may be sent. As Walker's final message is a postal mailing, there is disclosure to consider such testable characteristics as an e-mail subject, nor delivery date and time, nor other characteristics that are controllable within the e-mail domain but not within the postal mailing domain.

Finally, the Examiner asserts that Walker teaches random selection. Walker does teach this capability, but not within the context of amended claim 1 of the present application, of which claim 6 is dependent.

It is notable that the Examiner did not separately address claim 7 but did group it with claim 1 without noting any of the specifics of claim 7. In this case, Walker is silent on the evaluation of the final message that is sent after the test message is sent. This silence of Walker results from Walker's final message being a postal mailing, which is specifically difficult to track and measure for outcome. However, as the current application uses electronic messages in

both the test and final mailings, tracking both types of messages allows for more complete statistics and understanding of the subsequent accuracy of the initial sub-group sampling methodology.

Walker's teachings do not address, among other key aspects, that the final message is an electronic message as claimed by the Applicant. The Applicant's invention contains specific items that are distinct from Walker. Applicant therefore respectfully submits that Walker fails to teach or suggest all of the limitations of Claims 1-20.

II. Conclusion

Applicants respectfully submit the claims are in condition for formal allowance which is courteously solicited. If any issue regarding the allowability of any of the pending claims in the present application could be readily resolved, or if other action could be taken to further advance this application such as an Examiner's amendment, or if the Examiner should have any questions regarding the present amendment, it is respectfully requested that the Examiner please telephone Applicant's undersigned attorney in this regard. Should any fees be necessitated by this response, the Commissioner is hereby authorized to deduct such fees from Deposit Account No. 11-0160.

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Respectfully submitted,

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